

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/529,161
Applicant: Christian Mueller
Filed: February 27, 2006
Title: TEST HEAD POSITIONING APPARATUS
T.C./A.U.: 3745
Examiner: Frank D. Lopez
Confirmation No.: 2080
Docket No.: ITC-331US

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is necessitated by 1) a change in the basis of each rejection, and 2) an argument by the USPTO that a modification of the prior art achieves "equivalence" with Appellants claimed invention.

APPELLANTS CLAIMS OBTAIN A RESULT THAT IS NOT EXPECTED BY THE PRIOR ART.

Appellants claims achieve a result that the cited prior art can not achieve. Hence, the rejection is improper.

Referring to Appellants' Fig. 3, lifting device 20 can raise or lower second member 13 in order to raise and lower first member 8. However, first member 8 is movable independently of listing device 20. These are not only structural features - these are also results that the prior art can not achieve. Appellants' claims specifically recite these structural features and unique results:

... a lifting device for raising and lowering said second member in order to raise and lower said first member ...

... said fluid compartment allows said first member to be moved independently of said lifting device.

This result (which is not achieved by the prior art) is described in Appellants' specification at page 12, lines 1-16. Thus, by moving outer cylinder 8 up and down, the elevation position of the test head can be fine tuned. In this way a suspended or "floating" system is provided.

The first of the Examiner's 103 rejections previously (i.e., in the last Official Action) turned Fig. 4b of Slocum upside down. In the Examiner's Answer, there is no explicit statement that Slocums' Fig. 4B has been turned upside down. The Examiner's Answer does, however, analogize Appellants' first member to be Slocums' item 470 and Appellants' second member to be Slocums' item 468. Appellants, as previously stated, are able to raise and lower their second member in order to raise and lower their first member. Appellants' fluid compartment, as previously stated, allows Appellants to move their first member independently of the lifting device (which moves Appellants' second member). Slocum can not achieve those results. Regarding the Examiner's second rejection, the Examiner continues to explicitly state that he relies on Fig. 4B of Slocum being turned upside down. Slocums' variable fluid compartment is mounted to a base. If Slocums' Fig. 4B is turned upside down, the Examiner's Answer is silent as to what Slocums' variable fluid compartment would be mounted to. In addition, Appellants claimed feature of "a top of said second member defining a variable size fluid compartment within said first member" is missing from the Examiner's reconstruction of the Slocum reference. Where, in the Examiner's reconstruction, is the "top of said second member?"

THE REJECTIONS IN THE EXAMINER'S ANSWER ARE DIFFERENT THAN THE REJECTIONS IN THE LAST OFFICIAL ACTION.

Appellant notes that the Examiner has now changed the basis of the rejections. It is assumed that the basis of the rejections have been changed in response to the Appeal Brief filed on July 21, 2010. In particular, the Board is respectfully requested to compare the second paragraph which appears on page 5 of the Examiner's Answer and the second full paragraph which appears on page 5 of the Official Action dated December 1, 2009. The Examiner's Answer does not clearly state that the basis of the rejections have changed.

The new basis of the first rejection is not understood. For convenience, the new basis of the first rejection is reproduced below:

When the first member is added to the second member of the first embodiment, the support would be attached to the first member, and

the fluid compartment would be formed by a top portion of the second member

On page 7 of the Appeal Brief, Appellant attempted to try to visualize what the rejection was trying to say. The Examiner's Answer indicates that Appellant's understanding is incorrect. On page 8 of the Examiner's Answer, it is stated, "based on Appellant's remarks and drawings, it is clear that Appellant has failed to understand the rejection."

If it is "clear" that Appellant has failed to understand the rejection, then why did the PTO change the basis of the rejection?

Appellant respectfully maintains that the rejection itself is still unclear. Based on the second full paragraph which appears on page 5 of the Examiner's Answer, Appellant's claims still do not result. Appellant's claimed feature of "an interior of said first member and a top of said second member defining a variable size fluid compartment within said first member" is illustrated, for example, as item 23 of Appellant's Fig. 3. The Official Action has provided no explanation of how the prior art includes that feature.

MPEP 706.02(k) states:

It is important for an Examiner to properly communicate the basis for rejection so that the issues can be identified early and the Applicant can be given a fair opportunity to reply ... [I]t is important that the written record clearly explain the rationale for decisions made during prosecution of the application

Without a step by step explanation of how the prior art has been modified by the PTO to read on Appellant's claim, it is impossible for Appellant to provide a detailed response. Accordingly, the rejection is improper and should be withdrawn.

Regarding the second rejection, the Board is respectfully requested to note that the second rejection has changed as well. The Board is respectfully requested to compare the second full paragraph on page 7 of the Examiner's Answer with the first full paragraph which appears on page 7 of the Official Action dated December 1, 2009. The rejection in the Official Action reorients the second embodiment of Slocum while the second rejection in the Examiner's Answer reorients the lifting mechanism of Slocum. Again, if Appellant "clearly" did not understand the rejection, why was it necessary for the rejection to be changed?

Also, again, the KSR "articulated reasoning" for modifying the references has not be included in the Examiner's Answer. For this additional reason, the rejection should be reversed.

The Examiner's Answer then responds to Appellant's previous arguments. Regarding the first stated rejection, page 9 of the Examiner's Answer provides various details regarding a reconstruction of two different embodiments of the Slocum patent. Appellant has previously argued that there is no "articulated reasoning" for combining the two embodiments of Slocum. The Examiner's Answer responds by stating, "the Examiner contends that this is what is taught by the two embodiments of Slocum et al., starting with the first embodiment (Fig. 4A) and that this combination is operable and meets the claim limitations." (Examiner's Answer, page 9, lines 7-10). With regards to this explanation, Appellant relies on their previous argument which was, "why would one of ordinary skill in the art combine Slocums' two patents as the PTO as done?" The Examiner's Answer is devoid of any explanation. Appellant's question remains unanswered.

THE PRIOR ART LACKS "EQUIVALENCE" WITH APPELLANTS' CLAIMS.

On page 10 of the Examiner's Answer, the PTO offers a rational for modifying Slocums' embodiments. In particular, at page 4, line 10 of the Examiner's Answer it is stated, "by showing two embodiments ... one of ordinary skill would understand that the orientation of the lifting device does not matter, and that either orientation is equivalent to the other orientation. Equivalence is an accepted rational for modifying a reference."

First, the Examiner has not provided a legal basis for his "accepted rationale."

Second, Appellants' claims permit the first member to "float" ("said fluid compartment allows said first member to be moved independently") while also allowing the first member to be raise and lowered by raising and lowering said second member in order to raise and lower said first member"). The advantages of this feature are described in Appellant's result. Therefore, how can the PTO maintain that the prior art is an "equivalent" if it does not produce Appellants' results?

In addition, the established KSR requirement for maintaining a 103 rejection is "articulated reasoning." There is no articulated reasoning, there is no equivalence, and even by combing the references Appellant's claimed feature of "an interior of said first member and a top of said second member defining a variable size fluid compartment within said first member

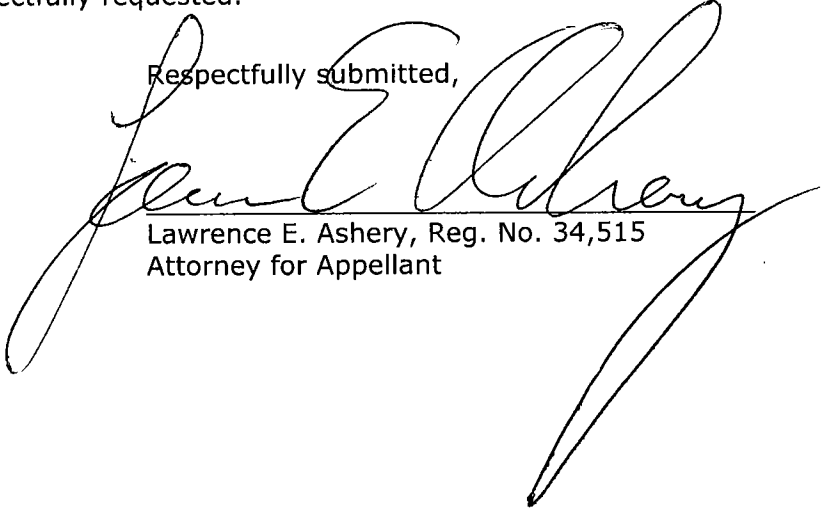
..." Accordingly, none of the requirements of a proper 103 rejection have been established. Appellant's claimed features are missing from the prior art and the prior art has been modified without providing articulated reasoning for doing so.

THE EXAMINER'S ANSWER "SOMEHOW" MODIFIES THE REFERENCE.

Page 10 of the Examiner's Answer responds to Appellant's previous argument that the functionality of the device is destroyed. In this regard, the Examiner's Answer states, "it is understood that the top of the second embodiment (i.e., 464, 462) is somehow connected to the support ..." The use of the word "somehow" in the Examiner's Answer again shows how the functionality is destroyed by the PTO's modification of the references. In the Appeal Brief, Appellants provided their understanding of how the reference has been modified. The Examiner's Answer argues that the Appellant's interpretation of the rejection is wrong, and yet does not provide a clearer picture of how the references have been modified.

Reversal of all rejections is respectfully requested.

Respectfully submitted,


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